

**REMARKS**

Claims 1-30 are pending in the present application. Reconsideration of the claims is respectfully requested.

**I. 35 U.S.C. § 102, Alleged Anticipation**

The Office Action rejects claims 1-30 under 35 U.S.C. § 102(e) as being anticipated by Poon (U.S. Publication No. 2002/0062265 A1). This rejection is respectfully traversed.

As to claims 1, 11 and 21, the Office Action states:

Ponn discloses a method and corresponding apparatus with means and computer program product with instructions for facilitating user selection of an item category in an online auction comprising receiving a registration request, the registration request including a service description and an identification of category within the taxonomy in which the service is to be registered, applying one or more canonical service description tests to the service description to determine if the service description should be registered in the category, and registering the service description in the identified category if a result of applying the one or more canonical service description tests is that the service description should be registered in the identified category (p. 49, 26-32); one or more canonical service description tests identify minimum criteria for the category (p. 49, 26-32); registering the service description in the category includes storing the service description and an associated model description in a storage association with the category (p. 49, 26-32); implementation in a service broker within at least one network (p. 49, 26-32); if the result of applying the one or more canonical service description tests is that the service description should not be registered in the category, a determination is made as to whether a request to add a new category is received (p. 49, 26-32); if a request to add a new category is received, a determination is made as to whether to add the new category, and wherein if the new category is added, the service description is registered in association with the new category (p. 49, 26-32); one or more canonical service description tests include information identifying minimum requirements of the category regarding one or more of security requirements, privacy requirements and communication protocol requirements (p. 49, 26-32); if the result of applying the one or more canonical service description tests is that the service description should be not registered in the category, searching the taxonomy for an alternate category in which the service description should be registered and registering the service description in the alternate

category (p. 49, 26-32); searching the taxonomy for an alternate category includes searching one or more of sibling, parent and child categories of the identified category within a predetermined range of the identified category in the taxonomy (p. 49, 26-32); and searching the taxonomy for an alternate category includes searching the taxonomy for a category in which the service description meets requirements of a canonical service description test associated with the alternate category (p. 49, 26-32).

Office Action dated June 7, 2005, pages 2-4.

Claim 1, which is representative of the other rejected independent claims 11 and 21 with regard to similarly recited subject matter, reads as follows:

1. A method in a data processing system of verifying a categorization of a service in a taxonomy, comprising:

receiving a registration request at the data processing system, the registration request including a service description and an identification of a category within the taxonomy in which the service is to be registered;

applying one or more canonical service description tests to the service description to determine if the service description should be registered in the category; and

registering the service description in the identified category using the data processing system if a result of applying the one or more canonical service description tests is that the service description should be registered in the identified category.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 21 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that Poon does not teach every element of the claimed invention arranged as they are in the claims. Specifically, Poon does not teach receiving a registration request at the data processing system, the registration request including a service description and an identification of a category within the taxonomy in which the service is to be registered, applying one or more canonical service description tests to the service description to determine if the service description should be registered in the

category, and registering the service description in the identified category using the data processing system if a result of applying the one or more canonical service description tests is that the service description should be registered in the identified category.

Poon is directed to a system for facilitating category selection by a user in a computerized auction. In the Poon system, a category field is provided, containing a plurality of category entries used to categorize an item in the auction. A client selects one category entry in a category field and a server provides at least one subcategory field. A plurality of subcategory entries is used to categorize the item in the auction, the subcategory entries corresponding to the user selected category entry of the plurality of category entries. At least one subcategory entry corresponding to the one selected category entry is further selected in the at least one subcategory field for further processing.

Thus, in the Poon system a user selects a category entry from a plurality of categories, and the server responds with a list of subcategories for the user selected category. This process continues until there are no further subcategories and then the final selected category is used for item registration. The Office Action alleges that Poon teaches receiving a registration request at the data processing system, the registration request including a service description and an identification of a category within the taxonomy in which the service is to be registered in paragraphs [0026]-[0032]. In this rather lengthy section, Poon merely receives a selection of a category from a user, determines if there are subcategories associated with the received category, and responds to the user with the subcategories if subcategories exist for the selected category. Thus, Poon fails to teach receiving a registration request that includes a service description and an identification of a category. The request sent from the client merely contains a selection of a category.

Additionally, Poon fails to teach applying one or more canonical service description tests to the service description to determine if the service description should be registered in the category. The server of Poon merely determines if there are related subcategories associated with the category selection received from the user. Nowhere in Poon is a test applied to a service description to determine if the service description

should be registered in the category as there is no service description received from the client in the Poon system.

Furthermore, Poon does not teach registering the service description in the identified category using the data processing system if a result of applying the one or more canonical service description tests is that the service description should be registered in the identified category. As discussed previously, Poon merely receives a category selection and does not apply one or more canonical service description tests to determine that the service description should be registered in the identified category. Poon relies on the user to determine what category the item should be listed in.

Thus, Poon does not teach each and every feature of independent claims 1, 11, and 21 as is required under 35 U.S.C. § 102. At least by virtue of their dependency on independent claims 1, 11, and 21, the specific features of dependent claims 2-10, 12-20, and 22-30 are not taught by Poon. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1-30 under 35 U.S.C. § 102.

Furthermore, Poon does not teach, suggest or give any incentive to make the needed changes to reach the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement Poon such that a registration request is received at the data processing system, the registration request including a service description and an identification of a category within the taxonomy in which the service is to be registered, one or more canonical service description tests are applied to the service description to determine if the service description should be registered in the category, and the service description is registered in the identified category using the data processing system if a result of applying the one or more canonical service description tests is that the service description should be registered in the identified category, one of ordinary skill in the art would not be led to modify Poon to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion or incentive to modify Poon in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicant's disclosure as a template to make the necessary changes to reach the claimed invention.

Moreover, in addition to their dependency from independent claims 1, 11, and 21, the specific features recited in dependent claims 2-10, 12-20, and 22-30 are not taught by

Poon. For example, with regard to claims 2, 12 and 22, Poon does not teach wherein the one or more canonical service description tests identify minimum criteria for the category. As discussed previously the only test applied by Poon is whether the user selected category has related subcategories. There is no test applied by Poon that identifies minimum criteria for the selected category.

With regard to claims 3, 13, and 23, Poon does not teach wherein registering the service description in the category includes storing the service description and an associated model description in a storage in association with the category. In the Poon reference only the final selected category that has no subcategories is recorded by the user. Poon does not provide for storing at the server any information from the client. Moreover, Poon does not receive a service description or an associated model description.

With regard to claim 4, 14, and 24, Poon does not teach wherein the method is implemented in a service broker within at least one network. While Poon may mention a network, nowhere in the Poon reference is a service broker even mentioned.

With regard to claim 5, 15, and 25, Poon does not teach wherein if the result of applying the one or more canonical service description tests is that the service description should not be registered in the category, a determination is made as to whether a request to add a new category is received. Poon merely teaches the server determining whether the user selected category has related subcategories. Nowhere in Poon is the addition of a new category mentioned.

With regard to claim 6, 16, and 26, Poon does not teach wherein if a request to add a new category is received, a determination is made as to whether to add the new category, and wherein if the new category is added, the service description is registered in association with the new category. As discussed previously, Poon does not teach the addition of a new category and does not teach service descriptions. Furthermore, Poon does not teach registering a service description in association with a new category.

With regard to claim 7, 17, and 27, Poon does not teach wherein the one or more canonical service description tests include information identifying minimum requirements of the category regarding one or more of security requirements, privacy requirements and communication protocol requirements. Poon does not teach receiving

service descriptions for the item for which the user selects a category. Thus, Poon does not teach applying a canonical service description test that identifies minimum requirements of the category using security requirements, privacy requirements, and communication protocol requirements.

With regard to claim 8, 18, and 28, Poon does not teach wherein if the result of applying the one or more canonical service description tests is that the service description should not be registered in the category, the method further comprises: searching the taxonomy for an alternate category in which the service description should be registered; and registering the service description in the alternate category. As discussed previously, Poon does not apply a canonical service description test and does not determine whether a service description should be registered within a specific category. Poon teaches determining whether the user selected category has related subcategories. Moreover, Poon does not teach or provide for searching for an alternate category in which the service description should be registered or registering the service description in the alternate category. Poon simply is not relevant to the present claimed invention.

With regard to claim 9, 19, and 29, Poon does not teach wherein searching the taxonomy for an alternate category includes searching one or more of sibling, parent and child categories of the identified category within a predetermined range of the identified category in the taxonomy. Nowhere in Poon is there a teaching of searching for an alternative category.

With regard to claim 10, 20, and 30, Poon does not teach wherein searching the taxonomy for an alternate category includes searching the taxonomy for a category in which the service description meets requirements of a canonical service description test associated with the alternate category. Nowhere in Poon is there a teaching of searching for an alternative category.

Therefore, in addition to being dependent on independent claims 1, 11, and 21, dependent claims 2-10, 12-20, and 22-30 are also distinguishable over Poon by virtue of the specific features recited in these claims. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 2-10, 12-20, and 22-30 under 35 U.S.C. § 102.

II. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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